

## REMARKS

### Change of Attorney

The original attorney of record in this case has changed careers, and the undersigned attorney is therefore filing this response on behalf of the Applicant. Due to time constraints, the undersigned attorney has not been able to obtain an executed Power of Attorney form. Such form will be submitted when received by the undersigned attorney.

### Claim Objections

Dependent claims 2, 6, 9, 15 and 18 stand objected to under 37 C.F.R. 1.75 (c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office Action states that these claims provide the method of using the sterile trolley and do not further limit the apparatus. Applicant has made minor amendments to claims 2, 6, 15 and 18. In other respects, Applicant respectfully submits that the objection to the claims was misguided on legal grounds, and should be withdrawn.

In this regard, the undersigned attorney refers the Examiner to MPEP §608.01(n), headings II and III. Under the "Examiner's Note" §608.01(n), the MPEP states:

Note *Ex parte Porter*, 25 USPQ 2d 1144 (Bd. Pat. App. & Inter. 1992) for situations where a method claim is considered to be properly dependent upon a parent apparatus claim and should not be objected to or rejected under 35 U.S.C. §112, fourth paragraph. See also MPEP §608.01(n), "Infringement Test" for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

The "Infringement Test" of §608.01(n) is explained in more detail under the heading III. This portion of the MPEP explains that a dependent claim does not lack compliance with 35 U.S.C. §112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2)

whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The MPEP emphasizes that the test to determine whether a claim is a proper dependent claim is whether the dependent claim includes every limitation of the claim from which it depends. The MPEP further goes on to explain that "The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper." Respectfully, Applicant contends that each of the dependent claim 2, 6, 9, 15 and 18 meet the "Infringement Test" and are therefore proper dependent claims.

Dependent claim 2 has been amended to clearly indicate that *the* continuously replenished rising layer of filtered air over the work surface finds antecedent basis in claim 1. Claim 2 meets the "Infringement Test" because it includes each and every limitation of the base claim 1. Dependent claim 15, which is dependent on independent claim 14, has been amended in a similar fashion to claim 2 for the same reason. It also meets the "Infringement Test".

Dependent claim 6, which is dependent on claims 5, 4 and 1, as well as dependent claim 18, which is dependent on claims 17, 16 and 14, have been amended to positively recite "sterilized surgical instruments set out on the work surface of the upper unit" as a further claim element to emphasize that these claims, as well, meet the "Infringement Test".

Claim 9, which is dependent on claim 1, has not been amended. Respectfully, Applicant believes that claim 9 meets the "Infringement Test" as well, and is therefore a proper dependent claim.

For the reasons argued above, Applicant respectfully request that the objection to dependent claim 2, 6, 9, 15 and 18 under 37 C.F.R. 1.75 (c) be withdrawn.

#### Information Disclosure Statement

Applicant submits herewith a Supplemental Information Disclosure Statement disclosing U.S. Patent No. 3,629,999 to Marsh, which was cited as a new reference on page 2 of the Examination Report dated September 18, 2008 on the corresponding

European application. A fee under §1.17(p) is due for submitting this Supplemental Information Disclosure Statement for consideration. Kindly charge the fee set forth in §1.17(p) to Andrus, Sceales, Starke & Sawall, LLP Deposit Account No. 01.2000.

Claim Rejections - Obviousness

Independent claims 1 and 12 have been rejected based on Howorth (US 4,531,956) in light of Lin et al. (US 6,694,892) and Von Otto (US 3,881,477). The Examiner contends that it would have been obvious in light of Lin et al. to provide the trolley disclosed in Howorth with an upstanding, hollow boundary wall. Furthermore, the Examiner contends that it would have been obvious to modify the trolley of Howorth in light of Von Otto such that the boundary wall emits filtered air on all sides. Applicant respectfully submits that claim 1 and 12 are not obvious based on Howorth in light of Lin et al. and von Otto. The invention differs from Howorth by having air outlets that direct sterile air only substantially inwardly of the boundary wall as recited in claims 1 and 12, not vertically from the work surface as disclosed in Howorth. As explained in the specification (see page 2, lines 11-12), airflow vertically upwards from the work surface increases the risk of entraining blood from the instruments replaced on the work surface into the air stream as an aerosol.

Lin et al. teaches use of an upstanding boundary wall with air *inlets* facing inwardly of the boundary wall (see Fig. 5) such that air is drawn into the boundary wall from above (see col. 4, lines 35-45). This is in contrast to the invention of claims 1 and 12, which specifies that air is emitted through air *outlets* in the boundary wall. A person having ordinary skill in the art applying the teaching of Lin et al. to the trolley of Howorth would provide the Howorth trolley with an upstanding boundary wall that draws in sterile air from above the work surface, rather than emits sterile air over the work surface from air outlets in the boundary wall as specified by claims 1 and 12.

Von Otto teaches use of a hollow tubular member 10 to be supported in the horizontal plane, spaced somewhat above a patient's body (see col. 2, lines 43-61). The hollow tubular member 0 has a multiplicity of jets A issuing from first series ports 32

surrounding the access opening 12, and also a second series of ports 34 directed downwardly from the member 10, discharging fluid in a multiplicity of jets B (see col. 3, line 22 to col. 4, line 19). This is in contrast to the invention of claims 1 and 12, which specifies that the air outlets in the boundary wall consist essentially of air outlets facing inwardly of the boundary wall over the work surface from opposing sides. A person having ordinary skill in the art applying the teaching of Von Otto to Howorth would modify the Howorth trolley to include a hollow tubular member spaced somewhat above the work surface, having ports directed inwardly and downwardly, which is substantially different from the claimed invention. The hollow tubular member 10 of Von Otto teaches that downwardly facing ports are required to provide a shield over the body or surface. It would therefore not have been obvious to apply the hollow tubular member 10 of Von Otto to a sterile air trolley as an upstanding boundary wall around a surface.

Independent claim 14 has also been rejected based on Howorth '956 in light of Lin et al. '892 and Von Otto '477. Claim 14 recites that the air outlets face *only* substantially inwardly towards the work surface from the boundary wall. It would not have been obvious to modify the trolley of Howorth in light of Lin et al. and Von Otto to provide an upstanding boundary wall wherein air is emitted through air outlets in the boundary wall, the air outlets facing only substantially inwardly towards the work surface from the boundary wall. First, Howorth has air outlets facing upwardly from the work surface, and there is no teaching in the other cited art to dispense with the upwardly facing outlets. Furthermore, a person applying the teaching of Lin et al. to the trolley of Howorth would provide the Howorth trolley with an upstanding boundary wall that draws in sterile air from above the work surface, rather than emits sterile air over the work surface from air outlets in the boundary wall. A person applying the teaching of Von Otto to Howorth would modify the Howorth trolley to include a hollow tubular member spaced somewhat above the work surface having ports directed inwardly and downwardly, not having ports facing *only* substantially inwardly toward the work surface from the boundary wall, as there is no teaching in Von Otto to use the hollow tubular member as an upstanding

boundary wall for a surface rather than a tubular member spaced apart from the work surface.

With regard to independent claims 1, 12 and 14, the Applicant has found that the arrangement of the present invention reduces the problems of turbulence in the airflow that would arise from the arrangement of the apparatus of Howorth, which has air outlets facing upwardly from the work surface. It was stated in the application as filed that prior art trolleys having air outlets in the work surface of the trolley, such as that of Howorth, provide an envelope of air that is disrupted by objects placed on the surface and gives rise to the risk of entrainment of blood from surgical instruments replaced on the work surface in the air flow as aerosol (see page 2, lines 7-13 of the specification).

New dependent claims 20 and 21, which depend from claims 1 and 14, respectively, specifically recite that no air outlets are directed upwardly or outwardly. This has support from the specification as filed from page 7, lines 32-36. Claims 20 and 21 are novel and inventive in light of Howorth, Lin et al. and Von Otto, as the sterile air trolley of Howorth has air outlets directed upwardly and outwardly from the work surface (see Fig. 2). there is no teaching in Howorth, Lin et al., or Von Otto to provide air outlets that only face inwardly of a boundary wall, and not to provide air outlets that face upwardly or outwardly.

For at least the above-explained reasons, Applicant requests that the rejection under 35 U.S.C. §103 to the independent and dependent claims be withdrawn.

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Conclusion

Applicant submits that the application as amended is in condition for allowance and earnestly requests allowance of the same.

Respectfully submitted,

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